

App. No. 10/568,131
DN: PHIT 8686 W1
Amendment Date: August 9, 2007
Reply to Office Action of April 9, 2007

REMARKS

Claims 1-11 are pending. Claims 1-11 are rejected.

Rejection of Claims 1-11 Under 35 U.S.C. §103.

Claims 1-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 3,687,136 issued to *Carmody* (hereafter referred to as "*Carmody*") in view of U.S. Pat. No. 5,120,325 issued to *Dow* (hereafter referred to as "*Dow*"), and U.S. Pat. No. 2,905,174 issued to *Smith* (hereafter referred to as "*Smith*").

Claims 7-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Carmody*.

Applicant respectfully traverses the Examiner's rejection of those Claims under 35 U.S.C. § 103. Specifically, Applicant believes the Examiner has not established a *prima facie* case of obviousness as required under patent law and in accordance with the Manual of Patent Examining Procedure ("MPEP"). The MPEP states,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed., Cir 1991) See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 706.02(j) (emphasis added).

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The Examiner has not shown that all elements of any of claims 1-11 are found in *Carmody*, or in the combination of *Dow* or *Smith*. In fact, there is at least one element specified in independent Claims 1 and 7 that are not suggested, disclosed, or claimed at all in *Carmody*. Additionally, none of these missing elements are disclosed or suggested by *Dow* or *Smith*. Specifically, none of the cited references disclose "an absorbent pad having a bottom side and a top side, the top having a non-toxic pigmented composition applied to it," or the step of "applying a non-toxic pigment to the top side of the pad".

As seen in Fig.1 of the applicant's application, the specification discloses a pad (3) having a top side (21), "on which a pigment is applied" (pg. 4 line 22). In contrast, *Carmody* does not apply pigment directly to a pad, but rather discloses, "a second strip of suitable color to match the skin...disposed between the transparent strip and the pad." (Col. 1, lines 11-15; Fig. 4). The Examiner acknowledges this distinction in the office action of 4/9/07, which states: "the bandage comprises a transparent backing (10), a pressure sensitive adhesive (12), a pad (16) and a pigmented plastic strip, which lays on top of the pad." (Emphasis added).

"Note that the omission of an element and retention of its function is an indicia of unobviousness." See MPEP 2144.04; also *In re Eagle*, 359 F.2d 896 (CCPA). Here, the invention of claim 1 and claim 7 has eliminated the "pigmented plastic strip", while maintaining the function of matching the skin tone of the user.

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Neither *Smith* or *Dow* suggest or disclose a pad with applied pigment or the step of applying pigment to a pad. Additionally, there is no suggestion or motivation to modify or combine *Carmody* with *Smith* or *Dow* either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art. The MPEP states,

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

MPEP § 2143.03.

In fact, *Smith* teaches away from such a combination by discouraging the use of transparent backing. *Smith* teaches that, "However, with a transparent backing, the unattractive back portion of the pad is clearly visible. Also, when the pad becomes soiled, for example, with wound exudate, the solid pad is clearly visible through the transparent backing, presenting an unsightly and unattractive appearance." Instead, *Smith* teaches the use of a pigmented backing, "provided with a plurality of flesh-colored markings". (Col. 3, lines 47-48). Likewise, *Dow* teaches, "It is critical to this invention that a non-toxic, pigmented composition is coated onto or embedded into the top side of the backing layer..." (Emphasis added)(Col. 3, lines 12-14).

Because *Carmody* does not disclose an absorbent pad, "having a non-toxic pigmented composition applied to it," or the step of, "applying a non-toxic pigment to the

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top side of the pad," applicant respectfully submits that *Carmody* does not suggest or disclose at least one element specifically required by independent Claims 1 and 7, and therefore, the Examiner fails to establish a *prima facie* case of obviousness against independent Claim 1 or Claim 7.

It is noted that independent Claim 1 forms the basis for all dependent Claims 2 - 6, and independent Claim 7 forms the basis for dependent Claims 8-11. Because a dependant claim cannot be obvious if the independent claim from which it depends is not obvious, all claims depending from Claims 1 and 7 must also be found nonobvious because all dependent claims of the present application depend from either independent Claim 1 or 7, each of which specifies an element not suggested or disclosed in the cited references.

The case of *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) does not alter the principles set out above based on the facts of the instant invention. There is nothing predictable in and from the prior art relied upon by the Examiner that yields applicant's invention as claimed. "Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.* at 1396. As the above references to the MPEP show, the law for generations has been that a patent

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comprised of several elements is not proved obvious merely by demonstrating that each of the elements were independently known in the prior art.

In light of the above, Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claims 1-11 as being obvious under 35 U.S.C. § 103.

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Conclusion.

Applicant believes the above analysis and the amendments made herein overcome all of the Examiner's rejections and that claims 1-11 are in condition for allowance. Therefore, applicant submits that claims 1-11 constitute allowable subject matter and should be favorably considered by the Examiner. The Applicant urges the Examiner to issue a timely Notice of Allowance for those claims.

The Commissioner is hereby authorized to charge any additional fees or credit overpayment under 37 CFR 1.16 and 1.17, which may be required by this paper to Deposit Account 162201.

Respectfully submitted,

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Scott Anthony Smith, Registration No. 46,067
PÖLSTER, LIEDER, WOODRUFF & LUCCHESI, L.C.
12412 Powerscourt Drive, Suite 200
St. Louis, MO 63131-3615
Telephone: (314) 238-2400
Facsimile: (314) 238-2401